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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,699	03/11/2005	Shu Kobayashi	050123	5316

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EXAMINER

PASTERCZYK, JAMES W

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 06/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/527,699

Applicant(s)

KOBAYASHI ET AL.

Examiner

J. Pasterczyk

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/11/05, 10/11/05</u> . | 6) <input type="checkbox"/> Other: ____. |

1. The abstract of the disclosure is objected to because it refers to the purported merits of the invention. Correction is required. See MPEP § 608.01(b).

2. Claims 4, 5, 8-10, 19 and 20 are objected to because of the following informalities: in claim 20, insert --an-- after “A method for”. In claim 19 insert --a-- after “A method for”. In claims 4, 5, 9 and 10, “kind of a” begs the question of what makes two things of the same “kind”, hence “kind of a” should generally be canceled in these claims, although claim 9 would need rewording and claim 10 would need “monomers” in the second line made singular. In claim 8, second page, the open bracket looks like it should be at the beginning of the line following the first structure instead of two lines above it; in the fourth line after the structure change “an” to --the-- since the aromatic ring must exist; likewise with the third line on the following page. Appropriate correction is required.

3. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, it is not clear what is meant by “physically carried”; is it simply entrained as in particles caught in filter paper?

In claim 6, l. 1-2, “the crosslinkable functional group” lacks antecedent basis.

In claim 7, it is not clear what the basis is of the ratio in the first line; is it weight, moles, volume, something else?

In claim 8, end l. 4 with --selected from the group consisting of-- for closed Markush language, and in l. 5 change “or” to --and-- twice. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the

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written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term “Y” in claim 8 is used by the claim to mean “alkylene group”, while the accepted meaning is “yttrium.” The term is indefinite because the specification does not clearly redefine the term. On the second and third page of claim 8, it is not clear which of many is being referred to by “the above aryl group”. At the bottom of p. 6 “arylacyloxy group” lacks antecedent basis.

In claim 17 it is not clear what is meant by “depositing”.

In claims 19 and 20 it is not really clear what type of compound is being made, i.e. what functional group is being made in the process recited, hence no good search is possible.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by each of Pittman, Jr. et al., USP 4,258,206 (hereafter referred to as Pittman), Zoeller et al., USP 6,452,043 (hereafter referred to as Zoeller), Corain et al., J. Mol. Catal. A: Chemical, vol. 173 (2001), pp. 99-115 (hereafter referred to as Kralik) and Reactive Polymers, vol. 15 (1991), pp. 135-145 (hereafter referred to as Toshima).

Pittman discloses the invention as claimed (abstract), as does Zoeller (abstract), Kralik (abstract) and Toshima (abstract).

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Pasterczyk whose telephone number is 571-272-1375. The examiner can normally be reached on M-F from 9 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached at 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



J. Pasterczyk

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5/30/06



J.A. LORENZO
SUPERVISORY PATENT EXAMINER